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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/303,368	04/30/1999	MARION SCOTT BRIGHT	BU9-99-021	8261

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EXAMINER

O'CONNOR, GERALD J

ART UNIT PAPER NUMBER

3627

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/303,368

Applicant(s)

Bright et al.

Examiner

O'Connor

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on September 21, 2004 (RCE and Amendment).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3, 4, 6, 8, 9, 11, and 13-31 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 4, 6, 8, 9, 11, and 13-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>20040921 and No. 40</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114 was filed in this application after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on September 21, 2004 has been entered.

Preliminary Remarks

2. This Office action responds to the amendment and arguments filed by applicant on September 21, 2004, in reply to the Decision on Appeal, mailed August 6, 2004.
3. The amendment of claims 1, 16, and 21 by applicant on September 21, 2004 is hereby acknowledged.
4. The addition of claims 25-31 by applicant on September 21, 2004 is hereby acknowledged.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-30 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The amendment filed September 21, 2004 introduces new matter into the disclosure. No amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: (1) that the order interceptor receives the electronic sales order “at different ordering stages,” as opposed to just when the order is placed/submitted by the customer (amended claims 1, 16, and 21); and, (2) that the order interceptor “build-ups the electronic sales order prior to transmitting to the order processing system” (amended claim 27).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 3-4, 6, 8-9, 11, and 13-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blinn et al. See, in particular, Figures 13 and 15.

Blinn et al. clearly anticipates all of the substantive elements of the instant invention, except that the system of Blinn et al. is an integrated, unitary system, performing all necessary processing steps/functions, whereas the system contemplated by the instant invention, while performing exactly the same steps/functions overall, merely splits the various processing steps/functions out into two separate processing systems, a “pre-processor” and a “processor.”

Thus, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Blinn et al., so as to split the processing steps/functions out into two separate modules or processing systems, a “pre-processor” and a “processor,” in order to improve overall system performance/throughput, since it is well settled that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

Regarding claim 31, Blinn et al. do not specifically teach splitting the electronic sales order into at least two separate requests prior to transmitting to the order processing system. However, splitting an electronic order into two separate requests is certainly a well known, hence obvious, step to follow on processing an electronic order. For example, when an electronic order is placed for two different items, one of which is in stock and one of which is not in stock, the electronic order is typically split into two requests, one for immediate fulfillment and one as a backorder for later fulfillment when the unavailable item later becomes available, the credit card of the customer being charged two times, one time for the first request (first half of the split order) at the time of fulfillment of the first request, then later for the second request (second half of the split order) at the later time of fulfillment of the second request.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Blinn et al. so as to split the electronic sales order into at least two separate requests prior to transmitting to the order processing system, as is well known to do, in order to allow items in stock to be fulfilled immediately and the credit card of the customer charged immediately for those items being fulfilled immediately, and to allow the items not in stock to be backordered for later fulfillment when the unavailable items become available, with the credit card of the customer then being charged at that later time for those items being later fulfilled, so as to expedite sales of available items while maintaining customer satisfaction by not charging the customer in advance for unavailable items, since so-doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

9. Claims 1, 3-4, 6, 8-9, 11, and 13-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al.

Johnson et al. clearly anticipates all of the substantive elements of the instant invention, except that the system of Johnson et al. is an integrated, unitary system, performing all necessary processing steps/functions, whereas the system contemplated by the instant invention, while performing exactly the same steps/functions overall, merely splits the various processing steps/functions out into two separate processing systems, a “pre-processor” and a “processor.”

Thus, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Johnson et al., so as to split the processing steps/functions out into two separate modules or processing systems, a “pre-processor” and a “processor,” in order to improve overall system performance/throughput, since it is well settled that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

Regarding claim 31, Johnson et al. do not specifically teach splitting the electronic sales order into at least two separate requests prior to transmitting to the order processing system. However, splitting an electronic order into two separate requests is certainly a well known, hence obvious, step to follow on processing an electronic order. For example, when an electronic order is placed for two different items, one of which is in stock and one of which is not in stock, the electronic order is typically split into two requests, one for immediate fulfillment and one as a backorder for later fulfillment when the unavailable item later becomes

available, the credit card of the customer being charged two times, one time for the first request (first half of the split order) at the time of fulfillment of the first request, then later for the second request (second half of the split order) at the later time of fulfillment of the second request.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Johnson et al. so as to split the electronic sales order into at least two separate requests prior to transmitting to the order processing system, as is well known to do, in order to allow items in stock to be fulfilled immediately and the credit card of the customer charged immediately for those items being fulfilled immediately, and to allow the items not in stock to be backordered for later fulfillment when the unavailable items become available, with the credit card of the customer then being charged at that later time for those items being later fulfilled, so as to expedite sales of available items while maintaining customer satisfaction by not charging the customer in advance for unavailable items, since so-doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Response to Arguments

10. Applicant's arguments filed September 21, 2004 have been fully considered but they are not persuasive.

11. Regarding the argument that the system of Blinn et al. "is not split into a pre-processing stage and a processing stage," applicant is correct, it is not. If such were the case, the claims

would have been rejected under 35 U.S.C. 102 as anticipated, rather than being rejected under 35 U.S.C. 103 for being obvious. A legal precedent is sufficient to establish a prima facie case of obviousness when the facts in the prior legal decision are sufficiently similar to those in an application under examination, as is the case here. As explained in the rejection, merely taking a known device and simply dividing it into pieces which together accomplish the same overall result is considered inherently obvious, as it is well settled that such a modification involves only routine skill in the art. The same response applies to applicant's arguments vis-à-vis Johnson et al.: that the system of Johnson et al. cannot be split into two systems because Johnson et al. do not disclose splitting the system into two systems, and that the system of Johnson et al. is not split into two systems. Again, it is considered inherently obvious to divide what is known into multiple pieces which accomplish the same overall result, since it is well settled that such a modification involves only routine skill in the art. For a further explanation of this type of obviousness rejection based on legal precedent, applicant can refer to MPEP § 2144.04.

12. In response to applicant's argument that the references applied in the rejection fail to use the same names for certain elements as the names used by applicant (i.e. "pre-processing" and "processing" versus "processing"), the argument is irrelevant, as it is noted that the disclosure in a reference must show the claimed elements arranged in the same manner as in the claims, but need not be in the identical words as used in the claims in order to be anticipatory. See *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990).

13. For further detailed rebuttal and discussion of applicant's arguments, attention is directed to the Examiner's Answer and to the Decision on Appeal, both incorporated herein by reference.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to the disclosure.

15. PLEASE TAKE NOTICE that the Technology Center and Group Art Unit numbers for prosecution of this application have been changed. The new Technology Center number is 3600. The new Group Art Unit number is 3627.

16. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, **Jerry O'Connor**, whose telephone number is (703) 305-1525, and whose facsimile number is (703) 746-3976.

The examiner can normally be reached weekdays from 9:30 to 6:00.

Inquiries of a general nature or simply relating to the status of the application should be directed to the receptionist, whose telephone number is (703) 308-1113.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Mr. Robert Olszewski, can be reached at (703) 308-5183.

Official replies to this Office action may be submitted by any *one* of fax, mail, or hand delivery. **Faxed replies are preferred and should be directed to (703) 872-9306 (fax-back**

auto-reply receipt service provided). Mailed replies should be addressed to "Commissioner of Patents and Trademarks, Washington, DC 20231." Hand delivered replies should be left with the receptionist on the seventh floor of Crystal Park Five, 2451 Crystal Dr, Arlington, VA 22202.

GJOC

January 10, 2005



Gerald J. O'Connor

Patent Examiner

Group Art Unit 3627